

REMARKS

The Examiner is thanked for the thorough examination of this application. The FINAL Office Action, however, has continued to reject all claims.

This application has three independent claims: 1, 17, and 19. Independent claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 5,687,215 to Timm et. Al, in view of U.S. published application *2005/0202799 to Rollender*. Independent claim 19 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Timm in view of *Rollender*, in further view of U.S. published application 2005/0153688 to Burkhart.

Thus, the Office Action relies upon the teachings of Rollender to reject each of the independent claims. Without Rollender, the rejection of each independent claim, and therefore all claims, must be withdrawn.

In fact, Rollender should be removed from consideration, as it does not constitute prior art to the present application. In this regard, Applicant invented the subject matter of the presently pending claims prior to the filing date of Rollender, and was diligent thereafter in preparing and filing the present application, such that Rollender should be removed from consideration.

In this regard, a declaration under 37 CFR 1.131 is submitted herewith. This declaration, and its accompanying exhibits, demonstrates both conception and diligence in the claimed subject matter of the present invention. Accordingly, Rollender should be removed from consideration. With Rollender removed from consideration, the rejections of all claims must be withdrawn.

Notwithstanding, Applicant maintains that the presently pending claims substantively distinguish over the cited art. The principal reference of Timm has already been distinguished in a previous response, and Applicant repeats and realleges those distinctions herein.

As a separate and independent basis for the patentability of all claims, Applicant respectfully traverses the rejections of these claims (under 35 U.S.C. § 103(a)) as failing to identify a proper basis for combining the cited references. In combining Rollender with Timm, , the Office Action stated only that the combination would have been obvious “for providing a call back number for the call center to call back in cases where the call is dropped or disconnected.” (Office Action, page 5, last two lines). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

“The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ...” Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.”

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also

requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a call processing system, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of the application and the timely allowance of all claims 1-17 and 19-31.

Cited Art


The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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